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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/972,313	11/18/97	PICKENS	T

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MM92/0314

EXAMINER	
TREMBLAY, M	
ART UNIT	**PAPER NUMBER**
2876	

DATE MAILED: 03/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/972,313	Pickens
Examiner	**Group Art Unit**
Tremblay	2876

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-9 and 13-27 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9 and 13-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Applicant: Thomas Boone Pickens III

Filing date: 11/18/97

Part III Action on the Merits

The request filed on 11/24/99 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/972,313 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7, 9, and 13-15 drawn to an optical scanning system, and claims 16-18, 20, and 23-27 drawn to an optical scanning method are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,804,803 to Cragun et al. ("Cragun" hereinafter). Cragun discloses an optical scanning system for scanning graphical codes 117 which are displayed on an object 115 to obtain the encoded Internet address for the object comprising:

an object 115 comprising:

text displayed on the object (see e.g. column 11, lines 28-51); and

at least one graphical code 117 displayed on the object, the graphical code further comprising an encoded Internet address (URL-- see e.g. column 4, lines 35-40);

scanning means 118 for optically scanning the graphical code; and

a computer 102 connected to the scanning means and further comprising processing means 104 for decoding the scanned encoded Internet address.

Cragun does not disclose a two dimensional codes. Two dimensional codes are old and well known. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a two dimensional code instead of a one dimensional code because two dimensional codes can store more information, as was widely recognized in the art at the time the invention was made. Thus, for a long Internet address, the two dimensional code can store all the information in a small space (e.g. on a small consumer item).

With respect to the size of the bar code being the same size as the text, this is merely a matter of changing the size of a known object which has no absolute size restrictions. The Minicode cited by Applicant is a case in point. The Examiner has cited further background information about the known code relied upon by Applicant. The Examiner notes that Applicant does not invent a new type of two dimensional code, but rather relies on the teachings of others. Minicode is typically on the order of 1 inch square. One proposed minimum is .6 inches by .6 inches (15.24 mm x 15.24 mm). The references incorporated by Applicant to support the "two dimensional" claim language do not cite a minimum size. It is clear that it is the Applicant's position Minicode can be any size the artisan wants, and no teaching is required concerning how to make the symbol smaller. Making the code smaller is easier than obvious; it is trivial. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the two dimensional code the same size as the text in order to fit the code within text that commonly appears on objects, so that preceding or succeeding lines of text wouldn't have to be spaced far apart. Note that since no text size is specified, the code might not be that small to meet the claims. The Examiner has cited

pertinent art to elucidate this point. In many cases, the text on objects has many different sizes. The Examiner has broadly interpreted the claim to mean that the code is at least smaller than the largest text on the document. See prior art cited.

Cragun discloses an optical scanning system as described above, but does not disclose a wireless infrared scanner. Official Notice is taken that wireless infrared scanners are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use an infrared scanner as a substitute for the 2.4 GH scanner mentioned by Cragun because an infrared scanner performs substantially the same function (transceives data) in substantially the same way (without wires) to obtain substantially the same result (a person can walk around with the terminal, but still send and receive data to another computer).

Re claim 12-13, 23-24 note that the bar code on the top of the Cragun patent is approximately 7mm high. Smaller bar code heights are old and well known.

Claims 8, drawn to an optical scanning system, and claims 19, 21-22 drawn to an optical scanning method are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,804,803 to Cragun et al. ("Cragun" hereinafter) in view of U.S. Patent #5,640,193 to Wellner ("Wellner" hereinafter). Cragun teaches the invention as described above, and further states that many different computer hardware and software configurations can be used to accomplish the objectives of the disclosure. See column 5, lines 1-52. Wellner teaches that bar codes can be used in a manner similar the URL in NCSA Mosaic, an Internet browser (see column 4, line 37). All that is required for a person of ordinary skill in the art is to buy a bar code "wedge" scanner (this type of scanner behaves exactly like a keyboard as far as the personal computer is concerned), and use it to scan in a URL written in Code 39 (for example-- code 39 fonts are available in WordPerfect and other popular word processing programs) when the cursor is positioned in the "Location" window of a browser. Cragun states that the disclosure applies to personal computers such as the Macintosh (column 5, line 37-38),

and Wellner describes a similar system and its likeness to a Web browser. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a Web browser as described by Wellner to receive the URL described by Cragun, because the Web browser was recognized as the easiest method for accessing data on the Internet using a personal computer such as an Apple Macintosh.

Internet

PTO maintains an extensive web site at http://www.uspto.gov. Communications about this application via e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be addressed to **mark.tremblay@uspto.gov**. All Internet e-mail communications will be recorded in the application. PTO employees don't use the Internet to exchange sensitive information unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. For more details, see the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Voice

General inquiries or status inquiries about this application should be directed to the Group 2800 Receptionist at (703) 308-0956. Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 8:30 am to 6:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Don Hajec, can be reached on (703) 308-4075. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

Fax Procedures

Application papers may faxed to Art Unit 2876 at (703) 308-7724. Faxes must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers solely for the examiner's consideration, and not intended for immediate entry into the application (e.g., a proposed amendment) should be unsigned and clearly marked "Draft Copy" and/or "Deliver Directly to Examiner."

Mark Tremblay
5/18/99